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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,747	06/13/2006	Jasmina Dokic-Gallagher	D0886-00158	1138

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DUANE MORRIS LLP - Philadelphia
IP DEPARTMENT
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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT	PAPER NUMBER
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1616

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/566,747	Applicant(s) DOKIC-GALLAGHER, JASMINA	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14, 16-20, 22-25 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 14, 16-20, 22-25 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/19/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-8, 14, 16-20, 22-25 and 28 are pending examination. Claims 9-13, 15, 21, 26 and 27 were cancelled in the preliminary amendment filed 2/01/2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "IPA" in claims 23-25 is used to replace the term "isopropanol", however, abbreviations cannot be used alone without a clear definition to accompany it. The term is indefinite because the metes and bounds of IPA can read on other terms having this abbreviation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 16, 17, 20, 22-25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Elgar et al. (GB 222949).

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Elgar et al. claim a method of controlling lice and their ova comprising applying a topical pharmaceutical composition comprising a solution of a film-forming polymer (0.1-5%), a conditioner (0.1-5%) and a plasticiser (0.1-5%) in an aqueous alcoholic or alcoholic medium (claim 1). Examples 6-9, and 11 include 0.1-0.5% Carbomer (Carbopol 934P) as a polymer. The plasticizer comprises a silicone (claim 9). The aqueous alcohol is selected from ethanol or isopropanol (claim 12). The composition may further comprise a surfactant and a lousicide selected from phenothrin, carbaryl and malathion (claims 13-17). The medium may contain between 0-100% alcohol (page 2, paragraph 3). Examples contain 0-50% alcohol.

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5, 8, 20 and 28 are rejected under 35 U.S.C. 102(a) as being anticipated by Shah (2004/0143026).

Shah discloses a cosmetic cream base made 0.3% Carbomer with 2% alcohol and surfactants [0042].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgar et al. (GB 222949) in view of Cardin et al. (US 5,292,504).

Applicant's Invention

Applicant claims a parasitic composition comprising at least one bioadhesive polymer and a carrier. Claim 7 further comprises a silicone selected from cyclomethicone. Claim 18 further comprises 0-10% of a cyclic siloxane, preferably decamethyl cyclopentasiloxane.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

The teachings of Elgar et al. are disclosed in above 102(b) rejection.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Elgar et al. do not teach the particular silicones used in the formulation are selected from cyclomethicone. It is for this reason that Cardin et al. is joined.

Cardin et al. teach ovicidal/pediculicidal compositions comprising pyrethrins and pyrethroids (abstract). The use of aryl siloxanes is considered essential in some formulation in order to achieve stability (column 2, lines 25-43). The formulations may comprise Carbopol and phenothrin (column 3, line 49; column 9, line 45). The most preferred siloxane is cyclomethicone.

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

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It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Elgar et al. and Cardin et al. to further include cyclomethicone as a cyclic siloxane. One would have been motivated to include cyclomethicone because Cardin et al. teaches that siloxanes are essential to achieve stability and that cyclomethicone is preferred in ovicidal/pediculicidal compositions.

Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elgar et al. (GB 222949) in view of Dunshee et al. (US 6,383,502).

Applicant's Invention

Applicant claims a parasitic composition comprising at least one bioadhesive polymer and a carrier. Claim 14 further comprises co-monomers. Claim 19 further comprises 0-10% of a cyclic siloxane, decamethyl cyclopentasiloxane.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

The teachings of Elgar et al. are disclosed in above 102(b) rejection.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Elgar et al. do not teach the particular silicone decamethyl cyclopentasiloxane. It is for this reason that Dunshee et al. is joined.

Dunshee et al. teaches compositions comprising 1-40% siloxane containing polymer in a alkane based siloxy polymer reaction for application to the skin in cosmetic

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or topical medicament compositions (abstract). This non-stinging coating comprises siloxanes and co-monomers selected from alkyl acrylates for the hard monomer component of the polymer (column 3, line 50 through column 5, line 30). Examples in Table 5 utilize cyclopentasiloxane as a volatile silicone solvent. The material forms a dried film when applied to a surface or the skin of the user (column 3, lines 1-3).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Elgar et al. and Dunshee et al. to further include co-monomers. One would have been motivated to include co-monomers because Dunshee et al. teach that co-monomers aid in film formation in the polymer reaction.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Elgar et al. and Dunshee et al. to further include cyclopentasiloxane. One would have been motivated to include cyclopentasiloxane because Dunshee et al. teach that it may be used as a volatile solvent in film formation used in application on the skin. Therefore, one of ordinary skill would have been motivated to include co-monomers and cyclopentasiloxane in the formulation disclosed by Elgar et al. in order to formulate a composition which forms a film when applied to the skin of the user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Danielle Sullivan
Patent Examiner
Art Unit 1616

/Mina Haghighatian/
Primary Examiner, Art Unit 1616